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## MESSAGE

Please direct this facsimile to patent examiner Justin P. King in Art Unit 2111. This facsimile concerns the following patent application

Serial No. 09/768,665

Applicant: Nguyen et al.

Filed: January 24, 2001

Invention: System and Method for the Handling of System Management Interrupts in a Multiprocessor Computer System

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Nguyen et al.

Serial No.: 09/768,665

Filed: January 24, 2001

Invention: System and Method for the  
Handling of System Management  
Interrupts in a Multiprocessor  
Computer System§  
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Group No.: 2111

Examiner: Justin King

**REQUEST FOR WITHDRAWAL OF FINALITY OF  
PREMATURE FINAL OFFICE ACTION**Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Applicants respectfully request that the patent examiner withdraw the finality of the premature final office action mailed January 14, 2004 ("the final office action"). Although the final office action is the second office action on the merits, the final office action is premature because it includes a new ground of rejection that was not necessitated by an amendment. Specifically, the final office action includes a new ground of rejection, including a new statutory

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basis for rejection and new art not previously of record, that was not necessitated by the amendment of claim 1 and claim 2 following the first office action.

**A. Factual Background**

This application was filed in January 2001. The application included claim 1 and claim 2, which depended from claim 1. In general terms, claim 2 added the limitation of the use of an arbitration scheme for selecting a processor. The Examiner issued a first office action in August 2003. In the first office action, the Examiner rejected claim 1 and claim 2 under 35 U.S.C. § 112 and 35 U.S.C. 102(a). The rejection of claim 1 under 35 U.S.C. § 102(a) in the first office action was based on U.S. Patent No. 6,272,618 to Tyner et al. *or* U.S. Patent No. 6,282,601 to Goodman et al. The rejection of claim 2 in the first office action was based only on Goodman. With respect to claim 2, the Examiner stated the following:

Referring to claim 2: Claim 1's argument applies; furthermore, *Goodman discloses an arbitration scheme* (the interrupt controller disclosed in column 1, line 46-47).

(First Office Action, page 14, emphasis added). As such, claim 2 was rejected as being anticipated by Goodman under 35 U.S.C. § 102(a).

The applicants submitted a response to the first office action. In the response, the applicants amended claim 1 by incorporating into claim 1 the limitations of dependent claim 2. The applicants cancelled claim 2. The applicants explained the amendment of claims 1 and 2 in the response:

Each of the independent claims has been amended herein so that, as amended, each includes the limitation of cancelled claim 2. Specifically, each of the independent claims has been amended so that each includes the limitation that the step of selecting a processor for handling the system management interrupt be "accomplished according to an arbitration scheme."

(Response, page 14). Thus, the only substantive amendment to claim 1 was to include the additional limitation of dependent claim 2. As such, the scope of amended claim 1 is the same as the scope of cancelled claim 2, a fact which was brought to the Examiner's attention. As such, amended claim 1 is a rewrite of cancelled claim 2 in independent form. Shown in the chart of Exhibit A is a comparison of claim 1 and claim 2, as filed and following the amendment submitted in response to the first office action. As can be readily seen from the chart of Exhibit A, the limitations of cancelled claim 2 (which are shown in italics) now appear in amended claim 1, and claim 1 is not otherwise substantively changed.

In the final office action, however, the Examiner asserts a new ground of rejection for claim 1. The Examiner rejects claim 1 as being obvious under 35 U.S.C. § 103(a) over Goodman or Tyner in combination with one of U.S. Patent No. 3,643,227 to Smith et al. or U.S. Patent No. 4,954,945 to Inoue. Neither Smith nor Inoue was cited as prior art in the first office action and were first introduced as prior art of record in the final office action. In the language of the final office action, the Examiner recognized that the arbitration scheme limitation is not disclosed or taught by Goodman:

Neither Tyner nor Goodman explicitly discloses or teaches selecting a designated SMI processor according to an arbitration scheme.

(Final Office Action, page 4). With this statement, the examiner reversed the stance previously taken with respect to Goodman and the claimed arbitration scheme in the original claim 2 ("Goodman discloses an arbitration scheme", First Office Action, page 14). Thus, to overcome the insertion of the limitations of claim 2 into claim 1, the Examiner asserts a new basis for rejection that employs (i) a new ground of rejection — Section 103(a) in place of Section 102(a) — and (ii) new art in support of rejection — Smith and Inoue in an attempt to correct the now

admitted deficiency in Goodman. Claim 1, which is a rewrite of claim 2 in independent form, is rejected in the final office action by a new ground of rejection that was not necessitated by any amendment of claim 1.

**B. Because the New Basis for the Rejection of Claim Was Not Necessitated by Amendment, the Finality of the Pending Office Action is Premature and Should be Withdrawn**

A second office action cannot be final if a new ground of rejection is asserted in the second office action that is not necessitated by the applicant's amendment of the claims. Manual of Patent Examining Procedure 706.07(a). Here, a new ground of rejection has been asserted with respect to claim 1. The Examiner has asserted a new statutory basis for rejection — Section 103(a) — and has also included new art not of record — Smith and Inoue.

Moreover, this new ground of rejection was not necessitated by amendment. The step of selecting a second processor for the handling of a system management interrupt according to an arbitration scheme has always been present in the claims. This limitation was the only limitation of original claim 2, and the entire limitation was inserted in amended claim 1 in conjunction with the cancellation of claim 2. As such, it cannot be argued that the amendment of claim 1 necessitated the new ground of rejection. This limitation was always present in claim 2, and claim 1 was amended to include this limitation, essentially rewriting claim 2 in independent form as amended claim 1.

That the Examiner has asserted a new basis for rejection is plain from the Examiner's reversal of his stance on the arbitration limitation of claim 2. In the first office action, the Examiner asserted that the arbitration language was disclosed by Goodman: "Goodman discloses an arbitration scheme". (First Office Action, page 14). The Examiner has now correctly indicated that Goodman does not teach or disclose the arbitration limitation:

"Neither Tyner nor Goodman explicitly discloses or teaches selecting a designated SMI processor according to an arbitration scheme." (Final Office Action, page 4). Because of Goodman's deficiency, the Examiner in the final office action has to assert two additional references (Smith and Inoue) and change the statutory basis of his rejection. Because a new basis of rejection that was not necessitated by amendment is asserted with respect to claim 1 (rewritten claim 2), the finality of the pending office action is improper and should be withdrawn.

Because the pending office action includes a new ground of rejection not necessitated by amendment, the applicants should not be placed in the position of having to respond to a final office action. In their response to the first office action, the applicants successfully demonstrated to the Examiner that the limitations of claim 2 were not disclosed by Goodman. The applicants should not now be forced to respond to the newly cited art from the procedural posture of a final office action, where the ability to amend claims to put them in condition for allowance is limited. Because a new ground of rejection not necessitated by amendment is asserted in the final office action, fairness and the established rules of practice require that the finality of this rejection be withdrawn.

#### Conclusion

Because of the premature nature of the finality of the pending office action, Applicants respectfully request that the Examiner withdraw the finality of the pending office action and *reissue* the office action as a non-final office action. Applicants request that the Examiner respond to this request at his earliest possible convenience. Applicants note that the two-month deadline for responding to the premature final office action expires on Monday, March 15, 2004, and the three-month deadline for responding to the premature final office action

expires on April 14, 2004. Applicants request that the office action be reissued as a non-final office action, thereby resetting the deadlines for response.

Respectfully submitted,



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Baker Botts Docket Number: 016295.0624

Date: March 12, 2004